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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,315	04/10/2002	Alejandro Berenstein	S63.2-10039	6886

490 7590 06/07/2010

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ART UNIT	PAPER NUMBER
3731	

MAIL DATE	DELIVERY MODE
06/07/2010	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/063,315
Filing Date: April 10, 2002
Appellant(s): BERENSTEIN ET AL.

Jonathan Grad
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/4/2010 appealing from the Office action mailed 7/30/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 38-41 and 43-55 are pending and finally rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,817,126	Imran	10-1998
6,336,937	Vonesh et al.	01-2002
5,911,732	Hojeibane	06-1999
5,593,442	Klein	01-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 38-41, 44, 46-49 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imran (5,817,126) in view of Vonesh et al. (6,336,937) and Hojeibane (5,911,732). Imran discloses a stent (see figure 1) having a coil segment (60) and serpentine segments (20 and 40). The coil portion has a greater length than either of the serpentine segments (see figure 1). However, Imran does not disclose one segment being self-expanding and the other segment being balloon expanding. Attention is drawn to Vonesh et al., who teach a stent may have some sections balloon expanding (56) and the adjacent segments self expanding (59, see figures 7 and 8) to create a stent where consistent performance along the length is not desired (see also

column 11, lines 47-59 and particularly lines 54-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the segmented stent of Imran with both balloon and self-expanding portions, as taught by Vonesh et al., to create a stent where consistent performance and expansion characteristics is not desired.

Further, the combination of Imran and Vonesh et al. does not disclose the middle segment is a coil segment. Attention is drawn to Hojeibane, who teaches the use of a coil segment (5, see figure 3) to connect non-coil segments (271 and 272) to increase the flexibility of the stent (particularly the region between the non-coil segments). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the segment (60) of the combination of Imran and Vonesh et al. a coil segment in the manner taught by Hojeibane to increase the flexibility of the stent.

Regarding claims 39 and 49, the end segments of the stent (20 and 40) are the serpentine segments.

Regarding claim 40, there is only one coil segment (60, which is replaced by a coil in the manner taught by Hojeibane described above) in the stent and that segment connects the two serpentine end segments.

Regarding claims 41 and 48, as taught by Vonesh et al., the first and second ends can be self expanding (as in figure 8 of Vonesh et al.).

Regarding claims 44 and 47, as taught by Vonesh et al., the first and second ends can be balloon expanding (as in figure 7 of Vonesh et al.).

Regarding claims 51-53, the combination of Imran, Vonesh et al, and Hojeibane does not disclose the specific sizes of the deployed segments. However, it has been held where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Claims 43, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imran (5,817,126) in view of Vonesh et al. (6,336,937) and Hojeibane (5,911,732) as applied to claims 38 and 46 above, and further in view of Klein (5,593,442). The combination of Imran, Vonesh et al, and Hojeibane does not disclose the segments be made of spring steel. Attention is drawn to Klein, who teaches it is well-known in the art to use spring steel in stents (see column 4, lines 53-60) to provide a stent with resiliency. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the stent segments of the combination of Imran, Vonesh et al, and Hojeibane of spring steel, as taught by Klein, to provide a stent that is resilient.

(10) Response to Argument

Appellant argues the reliance on Vonesh et al. to show some portions only balloon expanding and some portions only self-expanding is misplaced because it discloses the entire stent is self-expanding and a sleeve element (36) covers some portions of the stent whereby those covered portions need to be expanded by a balloon. Appellant recites column 11, lines 49-50 where Vonesh et al. state that section 56 is both balloon and self-expanding and section 58 is self-expanding only.

However, it appears applicant has simply ignored the rest of the disclosure of Vonesh et al. that Examiner pointed out in the advisory action of 11/9/2009. Namely, Vonesh et al. disclose at column 11, lines 54-59 that the device may likewise includes segments that are self-expanding and segments that are *not* self-expanding. Therefore, the disclosure of Vonesh et al. clearly contradicts appellant's position that the entire stent is self-expanding.

Further, regarding arguments stating that the difference in the claimed stent between the balloon expanding and self-expanding sections may, for example, be due to the material used to form those segments, Examiner notes that this is not a claim limitation. Therefore, the claims do not require different materials in the self-expanding and balloon expanding segments. Since this is not a claim limitation, even if Examiner had suggested including the sleeve (36) of Vonesh et al. on the Imran stent, the claims would not prevent such a construction because the stent would still have segments that could not expand due to the restraint offered by the sleeve. Examiner makes clear that this interpretation of Vonesh et al. was *not* relied upon in the rejection, but is being made for the sake of argument in response to appellants statements in the appeal brief.

Regarding the use of Hojeibane to teach the coil segments between non-coil segments, appellant argues one or ordinary skill in the art would not be motivated to use the coil of Hojeibane with the sleeve element of Vonesh et al. (see the first paragraph of page 15 of the appeal brief). However, as set forth above, the rejection did not rely on the use of a sleeve as taught by Vonesh et al. Therefore, arguments that including a coating or sleeve over the coil segment of Hojeibane would destroy the function of

Hojeibane (i.e. by interfering with expansion of the coil) are not persuasive because this notion was never suggested by the Examiner as is not required in the combination of prior art to meet the claim limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ryan J Severson/

Examiner, Art Unit 3731

Conferees:

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773

/Michael J Milano/

Primary Examiner